



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Conboy et al. Examiner: Butler, M.
Serial No.: 09/207,282 Group Art Unit: 3651
Filed: December 8, 1998 Docket No.: AMDA.379PA
Title: MANAGEMENT OF MULTIPLE TYPES OF EMPTY CARRIERS IN
AUTOMATED MATERIAL HANDLING SYSTEMS

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited in the United States Postal Service, in triplicate, as first class mail, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on March 4, 2002.

By: _____

Robert J. Crawford

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REPLY BRIEF

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GROUP 3600

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Reply Brief is submitted pursuant to 37 CFR §1.193(b)(1) for the above-referenced patent application and is being filed in triplicate. Appellant respectfully submits that the Examiner's Answer has raised arguments that are not supported by the record and that constitute new grounds of rejection, contrary to 37 C.F.R. §1.193(a)(2), as discussed below. Pursuant to §1.193(b)(1), Appellant respectfully requests that the Examiner enter this Reply Brief addressing the new grounds of rejection or withdraw the final rejection (and, if necessary, reopen prosecution). The new grounds of rejection are summarized and addressed below.

Further, Appellant's reply arguments, as presented herein, relate to the Issues on Appeal and Appellant requests that the Board consider these arguments, should the Examiner not withdraw the final rejection.

Appellant submits that the statement of the issues provided in the Appeal Brief is accurate with respect to the present invention. Notwithstanding, in the discussion that follows, Appellant answers each of the Examiner's issues by more specifically characterizing the issues that appear to be in dispute.

Addressing Examiner's SubIssues 1(a) and 1(c) :

Should the Section 1.130 Declaration Be Accepted By The Examiner At All?

This issue is moot because the Examiner already accepted the Section 1.130 Declaration per the Advisory Action (dated 05/18/01) which, in pertinent part, indicates that the Section 1.130 Declaration was entered to overcome the double patenting rejections against claims 1-9 and 19-20. The Section 1.130 Declaration is part of the record and cannot be ignored.

Should Section 1.131 Have Been Used As Proposed By The Examiner?

The Examiner erroneously argues in his subissues 1(a) and 1(b) that his suggestion for the Applicant to file a Section 1.131 Declaration was strategically discarded by Appellant to somehow take advantage of the Examiner. The Examiner fails to present a motive for the alleged strategy and, incredibly, fails to acknowledge that the impropriety of a Section 1.131 Declaration when the prior art and the rejected application are commonly owned. *See* p.5 (last few lines) of Appellant's Brief.

Contrary to the Examiner's understanding of MPEP 718, MPEP 718 clearly is not limited to an owner of a patent under reexamination. Rather, for the same reason that the Patent Office does not process interference proceedings between two commonly-owned entities, MPEP 718 prohibits "using 37 C.F.R. 1.131 to antedate a commonly owned U.S. Patent." It would be illogical to interpret the portion of MPEP 718 which states "an applicant or an owner of a patent under reexamination ..." as referring only to a "patent under reexamination"; this conclusion follows because there is no such thing as "an applicant ---- [of] a patent under reexamination ..." and because MPEP 718 would have referred to "an applicant for a patent or an owner of a patent under reexamination"

Accordingly, the Examiner's suggested recourse was wrong and, as indicated in the Examiner's Answer, the Examiner's arguments continue to rely on this erroneous interpretation of MPEP 718.

Was the Section 1.130 Declaration Submitted In A Timely Manner?

To the extent discernible, the issues raised by the Examiner under his subissue 1(b) appear to be directed to the timeliness of the Section 1.130 Declaration and whether a Section 1.130 Declaration would have been appropriate.

The Examiner's arguments concerning timeliness and the proper interpretation of MPEP 716.01A lack credibility. The Examiner erroneously suggests that MPEP 716.01A precludes acceptance of the Section 1.130 Declaration because it was not presented until after the final rejection. First, if the Section 1.130 Declaration were not submitted in a timely manner, the Examiner would never have entered Section 1.130 Declaration.

Second, MPEP 716.01A reveals that the Examiner should have entered the Section 1.130 Declaration. Contrary to the Examiner's misrepresentation in the Answer, MPEP 716.01A indicates that the after-final Section 1.130 Declaration was timely submitted. Rather, MPEP 716.01A states, in pertinent part: "The following criteria are applicable to all evidence traversing rejections submitted by applicants *** Affidavits and declarations *** traversing rejections are considered timely if submitted: *** (3) after final rejection and submitted (i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection." In this instance, Appellant was "overcoming a new ground of rejection or requirement made in the final rejection."

Although related, the new ground of rejection or requirement made in the final rejection is clearly apparent when comparing the rejected claims and the prior art. In response to the first Office Action, the claims were changed in effort to overcome the rejection. Moreover, in asserting the Section 103 rejection: the Examiner cited additional aspects of the Conboy '566 patent in an effort to substantiate correspondence to the amended claims; relied upon two new references which are Burney (c46 L38-54) and Tau et al. (c28 L 12-c29 ...); and, although still not providing evidence in support of the motivation for the asserted combination, the Examiner supplemented the rationale allegedly supporting the motivation by adding "knowing the attributes and features of the carriers assists in determining which carriers to move" to the previously-existing rationale of simply "global parameters are easy to transmit".

Accordingly, because the Examiner presented new grounds of rejection or requirements in the final rejection, MPEP 716.01A indicates that the after-final Section 1.130 Declaration was timely submitted and should be considered fully.

Addressing Examiner's Subissue 1(c).

With this subissue, the Examiner raises new arguments on appeal (regarding admissions, preclusion of use, and indistinct claims) and therefore contradicts 37 C.F.R. Section 1.193. With respect to the Examiner's newly-raised argument that "patentably indistinct claims could exist without an obviating disclosure," Applicant fails to appreciate where the Examiner is going with this issue and, for perhaps for this very reason, 37 C.F.R. Section 1.193 expressly prohibits new arguments from being raised. Notwithstanding, case law from the Court of Appeals for the Federal Circuit indicates that a terminal disclaimer does not constitute any kind of admission regarding the relationship between claims of the subject patent documents; thus, the Examiner suggestion to somehow read an admission into the record would seem highly improper.

Examiner's Issue 2.

Whether there is sufficient motivation to modify Conboy et al. '566 as claimed.

Again this issue, the Examiner raises new arguments on appeal and therefore contradicts 37 C.F.R. Section 1.193. The Examiner's arguments were never previously mentioned, are conclusions that have no evidentiary support whatsoever, and concern the Examiner's unsolicited opinions regarding how hypothetical programmers (in some unidentified field) have used and rejected various types of global parameters from the 1980's through the present time. The Examiner goes on with these new arguments by presenting his opinions on what is and is not an axiom of object-oriented programming; the term "object-oriented programming" is found nowhere in the specification or claims and nowhere else in the prosecution history.

Examiner's Subissues 3(a) and 3(b).

With these subissues, the Examiner has raised new arguments on appeal and, therefore, contradicted 37 C.F.R. Section 1.193. Under subissue 3(a), the Examiner argues in connection with Claim Group 1 by applying new portions of each secondary reference (new citations in *Tau ei al.* and new citations in *Burney*) to Claim Group 1. Further, the Examiner now proffers that "classifying the carriers" may be "deemed a synonym for types," based on yet another newly-introduced citation to *Tau ei al.* However, "groups" in this context are not inherently synonymous with "types." For example, "groups" may be selected for a variety of reasons such

as first-in-first-out queuing, and/or managing the size of sets rather than the type of sets. The Examiner's newly-asserted portions of these references do not substantiate the Examiner's arguments.

Under subissue 3(b), the Examiner argues in connection with Claim Group 1V also by applying new portions of the secondary references. The Examiner proffers as to the purpose of a routine described somewhere in *Burney* without any support or citation, and alleges that column 9, lines 45-65 of *Tau et al.* teaches "initializing a table of global variables" without any relationship to the rejection at large or to the claims specifically.

Not only are these cryptic arguments in violation of 37 C.F.R. Section 1.193 because they are new, the Examiner has not attempt to explain or evidence the motivation for this new combination of teachings.

Examiner's Subissues 3(c) and 3(d).

The Examiner alleges that Appellant's arguments under these issues are newly raised on appeal. While Applicant has not reviewed whether or not this allegation is true, it would seem likely that this allegation is true since the Examiner's final rejection presented new grounds of rejection.

Notwithstanding, Appellant submits that the Examiner has again raised new arguments on appeal and therefore, again, contradicted 37 C.F.R. Section 1.193. Under subissue 3(c), the Examiner argues in connection with claims 7 and 16 that "selecting carriers for movement contingent upon empty percentage is a prioritization." With this statement, the Examiner ignores the other claim language argued by Applicant including, for example, the language of claims 7 and 16 directed to "the priority of the certain carrier type and the priority of other carrier types". The Examiner cannot properly substantiate the rejection by simply alleging for the first time in the Answer that "an empty percentage" is the same as "the priority of the certain carrier type and the priority of other carrier types" used by the transportation system for moving the carriers.

Similarly under subissue 3(d), the Examiner argues in connection with claims 7 and 16 and ignores relevant other claim language argued by Applicant in the Appeal Brief. These are new citations and therefore constitute new arguments in violation of 37 CFR §1.193(a)(2).

II. Conclusion

Appellant submits that the claimed invention is patentable over the cited references, that the Examiner has violated of 37 CFR §1.193(a)(2) in presenting multiple new grounds of rejection, and attemptst to maintain rejections based on unsupported rationale. In view of the above arguments, Appellant respectfully requests reversal of the current and new rejections as applied to the appealed claims and allowance of the entire application.

Please charge Deposit Account number 01-0365 (TT2221) if it is believed that additional fees are necessary in connection with the filing of this Reply Brief.

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Respectfully submitted,



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